



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,617	02/02/2004	Wolfgang Eis	AMB-131-02	2301
24131 7590 02/06/2007 LERNER GREENBERG STEMER LLP P O BOX 2480 HOLLYWOOD, FL 33022-2480			EXAMINER HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
			1731	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/06/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/770,617

Applicant(s)

EIS ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11-29-2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-27 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the making-up device must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the spools and bundles as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

Applicant argues (page 14 of 12 June 2006 response) that page 28, lines 22-25 provides the definition for the "making-up" device. This definition requires "bundles" and "spools". Applicant's figure shows an invention which shows only one bundle and only one spool. Since the claims require (by way of the definition) spools and bundles, the drawings must show the plural bundles and plural spools.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

Art Unit: 1731

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "bush", "follow-up" and "making-up" are indefinite as to their meaning. See the 8-21-2006 Office action as to why these terms are indefinite.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 1731

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-11, 18-19, 21-23, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gouronnec 4373943 alone or in view of Watts 4204852 and Jensen 5062876.

See the 8-21-2006 Office action for the manner in which the art is applied.

Art Unit: 1731

Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanghera in view of Gouronnec, Watts 4204852 and Jensen 5062876 and Ishihara 2002/0078715.

See the 8-21-2006 Office action for the manner in which the art is applied.

Claims 1 and 11 and 13-17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanghera in view of Gouronnec, Watts and Jensen teachings (as discussed above).

See the 8-21-2006 Office action for the manner in which the art is applied.

See how Sanghera and Gouronnec are applied above.

Claims 1, 18 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Oh 6053013 in view of Gouronnec 4373943, Watts and Jensen teachings (as discussed above).

Oh teaches the basic invention, but not the multiple bushes, the follow device, and the other features of claim 1. It would have been obvious to improve the Oh invention, by multiplying all the parts in the manner that Gouronnec teaches, so as to be able to make a single multiple-fiber cable in a single process. All of the features of claim 18 are taught by Gouronnec as discussed above.

Claim 20: Oh teaches the use of a vacuum device as claimed.

Art Unit: 1731

Claims 25-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Lee or Gouronnec, Watts and Jensen teachings as applied to claim 1 above, and further in view of Holschlag 3304163 (and optionally Watts 4204852).

The primary references do not teach the cooling zone – but such is not structure and it is inherent that the fibers are cooled as discussed above. The primary references do not teach a funnel. However it is known that when drawing large number of fibers, that such draws along a large amount of air which causes problems as disclosed in Holschlag (col. 1, line 26 to col. 2, line 7). The solution to this problem is to utilize funnel-type guides (see Holschlag drawings and col. 4, lines 43-71). It would have been obvious to utilize Holschlag's teachings (i.e. the use of funnels) to improve the drawing process so as to prevent the problems that Holschlag teaches.

Watts is optionally cited to show it would have been obvious to draw a large number of fibers (more than 1000 fibers) (see above).

Response to Arguments

Applicant's arguments filed 11/29/06 have been fully considered but they are not persuasive.

Applicant points out that spools and bundles are not specified in the claims, and thus need not be shown in the drawings. The objection to the drawings has been changed to reflect the exact language of the claims (see above).

Art Unit: 1731

It is argued that the bundles and spools could not be shown in figure 1 because they would be into the paper. This is largely irrelevant, because there is no requirement to edit figure 1. Applicant can add an additional figure to overcome the objection.

It is further argued that figure 1 "represents spools and bundles". Examiner cannot find any such representation in the figure, nor does applicant point such out.

It is still further argued that spools and bundles can be replaced. Examiner understands that this argument to mean that the claim encompasses, spools/bundles before/after the process – for example a spool of fiber that has been shipped to a customer, or a spool in a spool-manufacturing plant that will be shipped to the fiber – making plant. There is nothing in the specification that supports such an assertion. Regardless – the Office exists to promote the useful arts – this includes requiring applicant to show in the figures what they invented.

Regarding the terms "follow-up" and "making-up", applicant refers to German terms. Applicant gives no evidence to support the assertions regarding meaning of German words.

From MPEP 2145 Consideration of Applicant's Rebuttal Arguments

I. ARGUMENT DOES NOT REPLACE EVIDENCE WHERE EVIDENCE IS NECESSARY

Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art.

The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

Art Unit: 1731

Applicant also points out that Applicants can be their own lexicographer. This is largely irrelevant because to because Applicant has not acted as their own lexicographer – this must be done at the time of filing and in a clear, precise and deliberate manner.

The specification must clearly set forth the definition explicitly and with reasonable clarity, deliberateness and precision. *Teleflex Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.* 60 USPQ2d 1851, 1854 (fed. Cir. 2001) and MPEP 2111.01.

Examiner sees nothing at page 1, lines 12-23 , page 29, lines 10-26, page 28, lines 22-25 or anywhere else in the specification that shoes that applicant has set forth any definition with clarity, deliberateness and precision.

Applicant points out that that the devices are “described in the specification”. Description and definition are two different things. Examiner does not dispute that applicant describes certain features of a particular embodiments of the devices in question.

Regarding the term “bush” – Examiner sees nothing in the arguments beyond what was previously argued and responded to by Examiner. (see prior Office action).

As to the arguments that the previous drawing does not have sets of axes which are mutually parallel. This argument is true. However the rejection is still proper for the

Art Unit: 1731

other reasons of record. For example a 4x4 (square) matrix would have the parallel axes. As would 5x5 or substantially any size matrix larger than the 2x2.

Although applicant argues that this does not apply to a 4x4 matrix – examiner does not understand Applicant's point. It appears that applicant thinks the 2x2 matrix previously drawn is the 4x4 matrix. Examiner's reference to "4x4 matrix" refers to the common practice of designating the number of rows and the size of the rows – that is, 4 rows that have 4 members there in.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus, it does not matter that Jensen does not have particular claim features – the rejection does not assert that Jensen has the features that Applicant argues that Jensen lacks. The same applies to applicant's assertion that Watts does not have particular claim features. The same applies to applicant's assertion that Gouronnec does not teach the matrix.

It is argued that the references do not show or teach the matrix configuration. Examiner disagrees, Jensen discloses such. Furthermore, such would have been obvious; putting things in rows and columns probably is rarely a non-obvious advancement. In this case it clearly is not as per the evidence of record (i.e. the applied references).

Art Unit: 1731

Regarding Official Notice: applicant now traverses the Official Notice. This traversal does not appear to be timely – such is already considered to be admitted prior art. Moreover, the traversal is inadequate.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241

The traversal is based on "Examiner's remarks, which pertain to the disclosure of Gouronnec". Examiner can find little connection between the noticed fact (i.e. the specific fact set forth in the Official Notice) and applicant's traversal. Rather it appears that applicant merely points out why the noticed fact is not applicable to the applied patent references. Since applicant has not pointed out any supposed error in the noticed fact, nor provided the requisite statement is not considered to be common knowledge or well-known in the art, applicant's traversal is considered to be inadequate. More specifically: The Official Notice makes no reference to Gouronnec.

As to the argument that Sanghera, Oh and Ishihara does not teach the matrix configuration. This is not very relevant, the rejection sets forth the basis for the requisite matrix teaching.

It is argued that Sanghera does not disclose that the opening is configured for creating a laminar air flow. In response to applicant's argument: a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

Art Unit: 1731.

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. One can provide a laminar air flow in Sanghera if one show chooses. From MPEP 2112: "The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103." Sanghera has an opening, as does applicant's invention. Laminar flow can exist in any open space. Applicant has not provided any evidence or rationale to support a conclusion that Sanghera's apparatus cannot permit a laminar flow.

As to the request for a phone call so that patentable language can be worked out. It is well understood policy that examiners should call applicants whenever patentable subject matter is present. The current Examiner promises to call Applicant immediately if Examiner ever notices any patentable subject matter anywhere in the present application.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

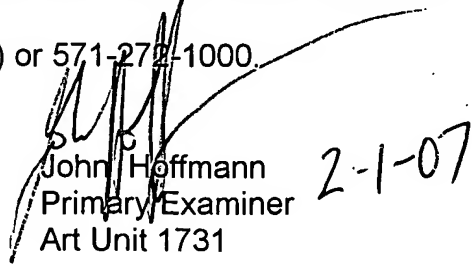
Art Unit: 1731

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John Hoffmann
Primary Examiner
Art Unit 1731

2-1-07

jmh